

### **REMARKS / ARGUMENTS**

The present application includes pending claims 1-28, all of which have been rejected. Applicants have amended claims 1, 8-10, 12-16, and 18-28 to further prosecution of the claims and to clarify the language used in these claims in light of the recent Federal Circuit decision in *SuperGuide Corp. v. DirecTV Enterprises, Inc., et al.*, 358 F.3d 870 (Fed. Cir. 2004). Applicants submit that these amendments do not add any new subject matter.

Claims 1-5, 7, 8-17 and 21-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent 6,463,445 issued to Suzuki, et al. (hereinafter, Suzuki). Claims 6 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki.

Applicants request reconsideration of the claims in view of the amendments and the following remarks.

#### **Claim Rejections under 35 U.S.C. § 102**

(paragraph 5 of the Office Action)

Claims 1-5, 7, 8-17 and 21-28 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Suzuki.

With regard to the anticipation rejection under Suzuki, MPEP 2131 states that "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 2 USPQ2d 1051, 1053 (Fed.Cir. 1987). MPEP 2131 also states that "[t]he identical invention must be shown in as complete detail as is contained in the ... claim."

*Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

With regard to the rejection of independent claim 1 under Suzuki, Applicants submit that Suzuki does not disclose or suggest at least the limitation of "a second communications device operatively coupled to the network, the second communications device receiving, from the first communications device, a device profile relating to the first communications device, and the second communications device sending the device profile and media content to the server, the server reformatting the media content based on the device profile," as claimed by the Applicants in independent claim 1. As shown in Figure 1 of Suzuki, Suzuki teaches that the data access server 220, and not the second communication device (multimedia contents server 210), receives the client information signal 242 (Suzuki, col. 6, lines 21-22), in contrast to what is recited by the Applicants in claim 1. Furthermore, Suzuki teaches that only multimedia content (246) and not device profile information is communicated from the second communication device (multimedia contents server 210) to the data access server 220 (Suzuki, col. 6, lines 22-34), which is also in contrast to what is recited by the Applicants in claim 1.

With regard to the rejection of independent claim 13 under Suzuki, Applicants submit that Suzuki does not disclose or suggest at least the limitation of "a first server" and "a second server operatively coupled to the first server," as claimed by the Applicants in independent claim 13. As shown in Figure 1 of Suzuki, Suzuki teaches only a data access server 220 which performs the transcoding (col. 7, lines 26-30), and does not teach a media exchange server, as disclosed by the Applicants in independent claim 13. Furthermore, Applicants submit that Suzuki does not disclose or suggest at least the limitations of "the first communications device sending a device profile of the first communications

device to the first server” and “the second communications device sending media content to the first server,” as claimed by the Applicants in independent claim 13.

Suzuki lacks support for a first and second server, as well as a first communications device and a second communications device, as disclosed by the Applicants in claim 13. The first server and the second server disclosed by the Applicants in independent claim 13 may correspond to the media exchange server 113 and the format conversion server 18, respectively, as shown in Figure 1 of the present application. As shown in Figure 1 of Suzuki, Suzuki teaches that the first communication device (client 230) sends client information signal 242 only to the data access server 220 which performs the conversion and not to a “first server” that is the source of media content, such as the media exchange server disclosed by the Applicants in the specification and claim 13 (Suzuki, col. 6, lines 21-22). In addition, the second communications device (multimedia contents server 210) does not send media content to a first server where the first server is a source of multimedia content, as claimed by the Applicants in claim 13.

With regard to the rejection of independent claim 16 under Suzuki, Applicants submit that Suzuki does not disclose or suggest at least the limitation of “a communications device operatively coupled to the network, the communications device receiving media content of a format that is not supported by the communications device and sending a device profile of the communications device and the received media content to the server,” as claimed by the Applicants in independent claim 16. As shown in Figure 1 of Suzuki, Suzuki does not teach that the communications device (client 230) receives “media content of a format that is not supported by the communications device,” as recited by Applicants in claim 16. Instead, Suzuki teaches that the original (non-transcoded content 246) is communicated from the second communication device (multimedia contents server 210) to the data access server 220, and not to the client 230 (col.

7, lines 23-24). In this regard, Suzuki only discloses that the client 230 communicates client information signal 242 (col. 6, lines 55-57) and that the client 230 receives transcoded multimedia content 244 (col. 7, lines 29-30).

With regard to the rejection of independent claim 21 under Suzuki, Applicants submit that Suzuki does not disclose or suggest at least the limitation of "receiving, by a first server, a device profile of a first communications device," as claimed by the Applicants in independent claim 21. The first server and the second server disclosed by the Applicants in independent claim 21 may correspond to the media exchange server 113 and the format conversion server 18, respectively, as shown in Figure 1 of the present application. As shown in Figure 1 of Suzuki, Suzuki teaches only a data access server 220 which performs the transcoding (col. 7, lines 26-30), and does not teach a first server, such as recited in claim 21, that receives a device profile of a communications device.

Based on at least the foregoing, the Applicants believe the rejection of independent claims 1, 13, 16, and 21 under 35 U.S.C. § 102(e) as being anticipated by Suzuki has been overcome and request that the rejection be withdrawn. Additionally, claims 2-5, 7-12, 14-15, 17, and 22-28 depend from these independent claims and are consequently also respectfully submitted to be allowable.

### **Claim Rejections under 35 U.S.C. § 103**

(Paragraph 7 of the Office Action)

Claims 6 and 18-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Suzuki.

With regard to an obviousness rejection, MPEP 2142 states that in order for a *prima facie* case of obviousness to be established, three basic criteria must

be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. *Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.* Further, MPEP 2143.01 states that “the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art suggests the desirability of the combination,” and that “although a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be *a suggestion or motivation in the reference to do so*’” (citing *In re Mills*, 916 F.2d 680, 16 USPQ 2d 1430 (Fed. Cir. 1990)). Moreover, MPEP 2143.01 also states that the level of ordinary skill in the art cannot be relied upon to provide the suggestion...,” citing *Al-Site Corp. v. VSI Int’l Inc.*, 174 F.3d 1308, 50 USPQ 2d 1161 (Fed. Cir. 1999).

With respect to the rejection of claim 6 which depends from independent claim 1, Applicants respectfully submit that Suzuki does not render claim 6 unpatentable at least for the reasons discussed above with respect to independent claim 1.

With regard to the third criterion stated above and in reference to independent claim 18, Applicants submit that Suzuki does not disclose or suggest at least the limitation of “sending the revisable device profile to a first communications device operatively coupled to the network, and receiving media content, from a second communications device operatively coupled to the network, wherein the multimedia content has been reformatted based on the device profile,” as claimed by the Applicants in independent claim 18. As shown in Figure 1 of Suzuki, Suzuki teaches that the first communication device (client 230) sends client information signal 242 only to the data access server 220 which

performs the transcoding and not to another communication device (Suzuki, col. 6, lines 21-22), in contrast to what is recited by the Applicants in claim 18.

Based on at least the foregoing, Applicants believe the rejection of independent claim 18 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki has been overcome and request that the rejection be withdrawn. Additionally, Applicants believe the rejection of dependent claims 6 and 19-20 under 35 U.S.C. § 103(a) as being unpatentable over Suzuki has also been overcome and request that the rejection be withdrawn.

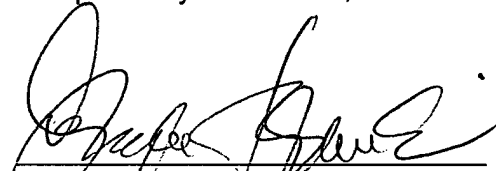
**CONCLUSION**

Based on the foregoing, Applicants believe that all claims 1-28 are in condition for allowance. If the Examiner disagrees, Applicants respectfully request a phone interview, and request that the Examiner telephones the undersigned attorney for Applicants at 312-775-8176.

The Commissioner is hereby authorized to charge any additional fees or credit any overpayment to the deposit account of McAndrews, Held & Malloy, Ltd., Account No. 13-0017.

A Notice of Allowability is courteously solicited.

Respectfully submitted,

  
\_\_\_\_\_  
Ognyan I. Beremski, Esq.  
Registration No. 51,458  
Attorney for Applicant(s)

Date: 13-OCT-2005

MCANDREWS, HELD & MALLOY, LTD.  
500 West Madison Street, 34th Floor  
Chicago, Illinois 60661  
(312) 775-8000